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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,962	01/23/2002	Kikukatsu Ito	2001_1838A	3213

513 7590 08/26/2003

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

MAYES, LAURIE A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 08/26/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,962

Applicant(s)

ITO, KIKUKATSU

Examiner

Laurie Mayes

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-6 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, 5, 6, drawn to a gene comprising cDNA and a DNA fragment.

Group II, claim(s) 3, 4, drawn to a thermogenic protein.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The DNA and protein of Group I and II have different structures and functions as the DNA encodes a protein while the protein may be used in an assay or to treat diabetes. Further, a DNA fragment comprising a partial sequence of SEQ ID NO: 1 is known in the art (see present claim 5)(WO 96/32483, SEQ ID NO: 130 and see attached copy of sequence alignment).

A telephone call was made to Lee Cheng on August 20, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Mayes whose telephone number is (703) 605-1208. The examiner can normally be reached on Monday through Friday from 9 AM to 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1123.

L. Mayes

Laurie Mayes
Patent Examiner
Art Unit 1653

Christopher S. Low

CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1800

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FASTA file: nucleic search, using sw model

Run on: August 13, 2003, 10:05:48 : Search time 806.815 Seconds
(without alignments)
1412.743 Million cell updates/sec

Title: US-10-009-962-1
Perfect score: 28
Sequence: 1 CCTCGAGAAAGCTTCAAGTCGAGG 28

Scoring table: IDENTITY_NUC
Gapop 10.0, bapext 1.0

Searched: 2088711 seqs, 2045481386 residues
Total number of hits satisfying chosen parameters: 5777422

Minimum LE seq length: 0
Maximum BE seq length: 200000000

Post-processing: Minimum Mat 4.0%
Maximum Match 100%
Listing first 45 summaries

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- 41: em_ba:*

Prod. No. is the number of results predicted by chance to have a

score greater than or equal to the score of the result being printed,
and is derived by analysis of the total score distribution.

SUMMARIES

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1	20.6	73.6	39	6	A57638	A57638 Sequa no 13
2	20.6	73.6	10277	1	AE009540	AE009540 Brucella
3	19.6	70.0	2322	8	AY120689	AY120689 Arabidops
4	19.6	70.0	2714	8	AF375436	AF375436 Arabidops
5	19.6	70.0	7142	1	PHMTFAX2G	PHMTFAX2G Arabidops
6	19.6	70.0	7142	6	AX385012	AX385012 Sequence
7	19.6	70.0	7142	6	AX385014	AX385014 Sequence
8	19.6	70.0	19768	2	AC098036	AC098036 Sequence
9	19.6	70.0	109016	8	ATT10817	ATT10817 Sequence
10	19.6	70.0	187649	2	AC124218	AC124218 Arabidops
11	19.6	70.0	193426	2	AC127443	AC127443 Rattus no
12	19.6	70.0	219635	2	AC127443	AC127443 Rattus no
13	19.6	70.0	231741	2	AC110855	AC110855 Rattus no
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15	19.2	68.6	4107	3	AY121618	AY121618 Sequence
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17	19.2	68.6	78491	9	AC139768	AC139768 Homo sapi
18	19.2	68.6	144404	8	AF003210	AF003210 Oryza sat
19	19.2	68.6	172515	2	AC139765	AC139765 Homo sapi
20	19.2	68.6	176933	3	AC009350	AC009350 Arabidops
21	19.2	68.6	177028	3	AC008315	AC008315 Arabidops
22	19.2	68.6	243348	3	AE003663	AE003663 Arabidops
23	19.2	68.6	244258	2	AC111517	AC111517 Rattus no
24	19.2	68.6	251872	2	AC125998	AC125998 Rattus no
25	19.2	68.6	663	11	BV041768	BV041768 S212P4029
26	19.2	67.9	1557	6	AX113891	AX113891 Sequence
27	19.2	67.9	2062	1	RCE302064	RCE302064 Burkholder
28	19.2	67.9	2225	8	ATG30855	ATG30855 A. thaliana
29	19.2	67.9	3684	10	AE156550	AE156550 Mus muscu
30	19.2	67.9	13882	3	CE14	CE14 A. thaliana
31	19.2	67.9	37628	3	AC006648	AC006648 Caenorhab
32	19.2	67.9	9113	9	ATG19493	ATG19493 A. thaliana
33	19.2	67.9	82646	8	AB028611	AB028611 Arabidops
34	19.2	67.9	177095	2	AC123330	AC123330 Rattus no
35	19.2	67.9	187755	2	AC005718	AC005718 Caenorhab
36	19.2	67.9	187755	2	AC005718	AC005718 Caenorhab
37	19.2	67.9	228381	2	AC103252	AC103252 Rattus no
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39	19.2	67.9	253171	2	AC111221	AC111221 Rattus no
40	19.2	67.9	252074	2	AC098624	AC098624 Rattus no
41	19.2	67.9	272166	2	AC120997	AC120997 Rattus no
42	19.2	67.9	274467	2	AC115707	AC115707 Rattus no
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44	19.2	67.9	300660	1	AP005946	AP005946 Bradyrhiz
45	19.2	67.9	302253	1	AP005220	AP005220 Bradyrhiz

ALIGNMENTS

RESULT 1:
A57638/c
LOCUS: A57638
DEFINITION: Sequence 130 from Patent WO95/2483.
ACCESSION: A57638
VERSION: A57638.1 GI:3713470
KEYWORDS: unidentified
SOURCE: unidentified
ORGANISM: unclassified.

REFERENCE: Masucci, M.G.
AUTHORS: IMMUNE-EVADING PROTEINS
TITLE: Patent, WO 9632483-A 130 17-OCT-1996;
JOURNAL: MASUCCI MARIA GRAZIA (SE)

linear PAT 95-MAP-1998

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